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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/591,073	06/09/2000	Jeffrey A. Norris	4284-5B2	2901

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EXAMINER

SUBRAMANIAN, NARAYANSWAMY

ART UNIT	PAPER NUMBER
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3624

DATE MAILED: 09/16/2002

4

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/591,073

Applicant(s)

NORRIS, JEFFREY A.

Examiner

Narayanswamy Subramanian

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 09 June 2000.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-20 and 65-95 is/are pending in the application.
- 4a) Of the above claim(s) 1-20 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 65-95 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 1-20 are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 2.
- 4) ☐ Interview Summary (PTO-413) Paper No(s) \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

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### **DETAILED ACTION**

1. Original claims 1-20 and 65-95 have been examined. The restrictions, objections and rejections are stated below.

#### ***Specification***

2. Applicant is reminded of the proper language and format for an abstract of the disclosure.

The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 150 words. It is important that the abstract not exceed 150 words in length since the space provided for the abstract on the computer tape used by the printer is limited. The abstract provided exceeds 150 words. Correction is required.

#### ***Election/Restrictions***

3. Restriction to one of the following inventions is required under 35 U.S.C. 121:

Group I: The independent claims 1, 10, 17 and the claims dependent thereof namely 2-9, 11-16 and 18-20 refer to a method and apparatus for automated processing of financial transactions, which is classified under class 705, subclass 43.

Group II: The independent claims 65, 76, 82, 90 and 95 and the claims dependent thereof namely 66-75, 77-81, 83-89 and 91-94 refer to a method and apparatus for automated loan processing, which is classified under class 705, subclass 38.

Inventions I and II are related as sub-combinations disclosed as usable together in a single combination. The sub-combinations are distinct from each other if they are shown to be separately usable. In the instant case, invention II has separate utility such as

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processing a loan application and facilitating payment of the loan if the loan is approved.

See MPEP § 806.05(d).

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

During a telephone conversation with Mr. Benjamin S. Withrow on August 11, 2002 a provisional election was made without traverse to prosecute the invention of Automatic Loan Processing, claims 65-95. Affirmation of this election must be made by applicant in replying to this office action. Claims 1-20 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention. Applicant is respectfully advised to cancel the non-elected claims in response to this office action.

#### ***Claim Objections***

4. Claims 65, 76, 89 are objected to because of the following informalities:

In claim 65, part © the numbering (iv) and (vi) are skipped. It is not clear if any of the steps are missing or if the claims are not sequentially numbered.

In claim 76 part c (iii), it is not clear if the phrase is supposed to read “information received from at least one data base relevant to the applicant’s identity” instead of “information received at least one data base relevant to the applicant’s identity”.

Claims 88 and 89 are identical.

Appropriate corrections are required.

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***Claim Rejections - 35 USC § 112***

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claim 65 refers to a "loan processing system". Claims 66-75 recite the limitation "automatic loan processing system" in the first line of the respective claims. There is insufficient antecedent basis for this limitation in the claims 66-75.

***Double Patenting***

7. The non-statutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper time-wise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a non-statutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

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1. Claims 65, 76, 82 and 95 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 13, 19 and 26 of co-pending Application No. 90/005311. Although the conflicting claims are not identical, they are not patentably distinct from each other because they recite the means or steps that are substantially the same and that would have been obvious to one of ordinary skill in the art.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claims 66-75, 77-81, and 83-94 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-28 of Norris (U.S. Patent 5870721). Although the conflicting claims are not identical, they are not patentably distinct from each other because they recite the means or steps that are substantially the same and that would have been obvious to one of ordinary skill in the art.

Claim 65 essentially repeats most of the features listed in claim 1 of Norris 90/005311.

Claim 66 essentially repeats all the features listed in Norris (5870721) claim 2 without the limitation of using only a printer to deliver the loan documentation. It would have been obvious to one with ordinary skill in the art to also include other devices that are capable of delivering the electronic documentation.

Claim 67 repeats the feature listed in Norris '311 claim 1 c(iii).

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Claim 68 repeats the feature listed in Norris '721 claim 3 with the phrase "applicant's account" replaced by "designated account". The phrase "issuing proceeds for the loan as requested by the loan applicant" in Norris claim 1 is interpreted to include transferring the proceeds of an approved loan amount into an account designated by the applicant.

Claims 69 and 70 combine the limitations of claim 2 of Norris '721. Proceeds of the loan could be printed as a check at the applicant's interface. Norris claim 1 recites issuing the proceeds of the loan and Norris claim 2 recites the delivery of loan documents using a printer. The loan documents are broadly interpreted to include the check also. It would have been obvious to one with ordinary skill in the art to adapt the printer to print checks so that the proceeds of the loan can be issued to the approved applicant.

Claim 71 is a repetition of claim 4 of Norris '721.

Claim 72 is a repetition of claim 6 of Norris '721.

Claim 73 is a repetition of claim 7 of Norris '721.

Claim 74 is a repetition of claim 9 of Norris '721.

Claim 75 is a repetition of claim 10 of Norris '721.

Claim 76 essentially repeats most of the limitations listed in Norris claim 13 '311.

Claim 77 is a repetition of claim 14 of Norris '721.

Claim 78 repeats the feature listed in Norris '721 claim 16 with the phrase "applicant's account" replaced by "designated account". The phrase "issuing proceeds for the loan as requested by the loan applicant" in Norris '311 claim 13 is interpreted to include transferring the proceeds of an approved loan amount into an account designated by the applicant.

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Claims 79 and 80 combine the limitations of claim 15 of Norris '721. Proceeds of the loan could be printed as a check at the applicant's interface. Norris '311 Claim 13 recites issuing the proceeds of the loan and Norris '721 claim 15 recites the delivery of loan documents using a printer. The loan documents are broadly interpreted to include the check also. It would have been obvious to one with ordinary skill in the art to adapt a printer to print checks so that the proceeds of the loan can be issued to the approved applicant.

Claim 81 is a repetition of claim 17 of Norris '721.

Claim 82 essentially repeats most of the limitations listed in Norris '311 claim 19.

Claim 83 is a repetition of claim 20 of Norris '721.

Claim 84 is a repetition of claim 19(d) of Norris '721.

Claim 85 repeats the feature listed in Norris '721 claim 21 with the phrase "applicant's account" replaced by "designated account". The phrase "issuing proceeds for the loan as requested by the loan applicant" in Norris '311 claim 19 is interpreted to include transferring the proceeds of an approved loan amount into an account designated by the applicant.

Claim 86 is a repetition of claim 22 of Norris '721.

Claim 87 is a repetition of claim 23 of Norris '721.

Claims 88 and 89 are a repetition of claim 24 of Norris '721.

Claim 90 essentially repeats most of the limitations listed in Norris '311 claim 13 with the phrase "Automatic loan processing system" essentially replaced by "computer readable medium comprising software for instructing a computer to". The nature and complexity of the tasks involved in automatically processing a loan is such that it cannot



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be done in real time without the use of a computer system. A computer system implies a computer readable medium comprising software for instructing a computer to perform the tasks. Hence a “computer readable medium comprising software for instructing a computer” is implied in claim 13 of Norris ‘311.

Claim 91 is a repetition of claim 19(d) of Norris ‘311, with the phrase “computer readable medium comprising software for instructing a computer” implied in the claim.

Claim 92 repeats the feature listed in Norris ‘721 claim 21 with the phrase “applicant’s account” replaced by “designated account”. The phrase “issuing proceeds for the loan as requested by the loan applicant” in Norris ‘311 claim 13 is interpreted to include transferring the proceeds of an approved loan amount into an account designated by the applicant. Also the phrase “computer readable medium comprising software for instructing a computer” is implied in the claim.

Claims 93 and 94 combine the limitations of claim 15 of Norris ‘721. Proceeds of the loan could be printed as a check at the applicant’s interface. Norris ‘311 Claim 13 recites issuing the proceeds of the loan and Norris ‘721 claim 15 recites the delivery of loan documents using a printer. The loan documents are broadly interpreted to include the check also. It would have been obvious to one with ordinary skill in the art to adapt a printer to print checks so that the proceeds of the loan can be issued to the approved applicant. Also the phrase “computer readable medium comprising software for instructing a computer” is implied in the claim.

Claim 95 essentially repeats most of the features listed in Norris ‘311 claim 26.

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***Conclusion***

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

(a) Jones et al (US Patent 5239462)(August 24, 1993) Method and apparatus for automatically determining the approval status of a potential borrower

(b) Lockwood (US Patent 5576951) (November 19, 1996) Automated sales and services system

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dr. Narayanswamy Subramanian whose telephone number is (703) 305-4878. The examiner can normally be reached Monday-Thursday from 8:30 AM to 7:00 PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vincent Millin can be reached at (703) 308-1065. The fax number for Formal or Official faxes and Draft or Informal faxes to Technology Center 3600 or this Art Unit is (703) 305-7687.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-1113.

N. Subramanian  
September 1, 2002

  
**VINCENT MILLIN  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 3600**